

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office action dated June 15, 2005 are respectfully requested. Applicants thank the Examiner for an indication that claims 10-19 are allowed.

I. Amendments

Claims 1 and 20 are amended to recite the advancement device is disposed within the housing interior. Basis for this amendment can be found in Fig. 1, as an example.

No new matter is added by way of these amendments.

II. Rejection under 35 U.S.C. § 102

Claims 1-7 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Cosman *et al.* (U.S. Patent No. 6,530,922).

These rejections are respectfully traversed.

A. The Present Invention

The present invention, as embodied by claim 1, describes a method of controlling an ablation volume depth during surface treatment including the step of providing an apparatus with a housing and an advancement device disposed inside the housing interior and being coupled to an energy delivery device, where the advancement device is configured to selectively advance individual electrodes of a plurality of electrodes from the housing interior to a selected deployment depth.

B. The Prior Art

COSMAN ET AL. describe a device for ablation of tissue. The device generally includes a cluster or array of electrodes. Various embodiments of the device are described. In one embodiment, (Fig. 7, Col. 12, lines 20-47), the device includes electrodes attached to a plunger hub, which slides in a carrier or sheath.

In another embodiment, illustrated in Fig. 10 (Col. 15, lines 24-45), the ablation device contains three electrodes that are inserted into an organ using a guide block (Col. 15, lines 42-44). The guide block serves to direct the electrodes to the desired site within the tumor.

C. Analysis

The method of instant claims 1 and 20 include providing an apparatus including an advancement device disposed inside the housing interior.

Nowhere do Cosman *et al.* teach providing an apparatus that includes an advancement device disposed inside the housing interior that is configured to selectively advance individual electrodes of a plurality of electrodes from the housing interior to a selected deployment depth. Instead, the advancement device of Cosman *et al.* is a plunger.

Accordingly, Applicants submit that standard of strict identity to maintain a rejection under 35 U.S.C. § 102 has not been met and withdrawal of the rejections under 35 U.S.C. § 102(e) is respectfully requested.

III. Rejections under 35 U.S.C. §103

Claims 8, 9, and 20 were rejected under 35 U.S.C. §103 as allegedly obvious over Cosman *et al.*, further in view of Behl *et al.* (U.S. Patent No. 6,337,998).

These rejections are respectfully traversed.

A. The Present Invention

The instant method, according to claims 8 and 9, is described above. The method according to claim 20 includes providing an apparatus that includes an advancement device disposed inside the housing interior that is configured to selectively advance individual electrodes of a plurality of electrodes from the housing interior to a selected deployment depth.

B. The Prior Art

COSMAN ET AL. is described above.

BEHL ET AL. describe a system for treatment of target region beneath a tissue surface comprising a probe for deploying an electrode array within the tissue and a cover for engaging the tissue surface above the treatment site. The cover may be a rigid plate and may be clipped or otherwise removably attached to the probe. The cover may comprise electrode(s) or be electrically neutral.

C. Analysis

According to MPEP § 2143, one of the three basic criteria that must be met to establish a *prima facie* case of obviousness is that the prior art references (or references when combined) must teach or suggest all the claim limitations.

As noted above, Cosman *et al.* fail to teach providing an apparatus including an advancement device disposed inside the housing interior.

The teaching in Behl *et al.* does not make up for this deficiency. The system of Behl *et al.* includes (i) a probe for deploying an electrode array at a tissue site and (ii) a surface electrode for engaging the tissue surface above the treatment site. As seen in Fig. 2, the surface electrode is a rigid plate and does not include either a housing with an interior or an advancement device for the electrodes, much less one disposed inside the housing interior.


Because the references, alone or in combination, fail to teach all the claim limitations of the present invention, the standard for obviousness has not been met. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103.

CONCLUSION

In view of the foregoing, Applicants submit that the claims pending in the application are in condition for allowance. A Notice of Allowance is therefore respectfully requested.

The Examiner is invited to contact Applicants' representative at (650) 838-4410 if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,


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